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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,803	02/02/2001	Theodore C. Jacoby JR.	7812	9650
1688	7590	01/28/2005	EXAMINER	
POLSTER, LIEDER, WOODRUFF & LUCCHESI 12412 POWERSCOURT DRIVE SUITE 200 ST. LOUIS, MO 63131-3615			GARG, YOGESH C	
		ART UNIT		PAPER NUMBER
		3625		

DATE MAILED: 01/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	09/773,803	Applicant(s)	JACOBY, THEODORE C.
Examiner	Yogesh C Garg	Art Unit	3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 November 2004.
2a) This action is FINAL. 2b) This action is non-final.
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-71 is/are pending in the application.
4a) Of the above claim(s) 1-3,8-11 and 29-71 is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 4-7 and 12-28 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment received on November 8, 2004 is acknowledged and entered.

The applicant has withdrawn claims 1-37. The applicant has added new claims 38-71.

Currently claims 38-71 are pending for examination.

Election/Restrictions

2. Newly submitted claims 38-71 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 38-71 are directed to a computer-readable medium encoded with program instructions for facilitating on-line brokerage operation of goods classified in class 705, subclass 26 and the originally claimed invention of originally filed claims 4-7 and 12-28 on 2/2/2001 was drawn to a computerized system comprising interfaces for receiving, returning and displaying information from other terminals, classified in class 709, subclass 203 (Note: A First office action on merits was mailed on 4/1/2004 including rejection of claims 4-7 under 35 USC 102 (e) and rejection of claims 12-28 under USC 103 (a) was mailed).

Therefore, the inventions are distinct, each from the other because: Inventions presented now via newly added claims 38-71 have separate utility such as requiring an apparatus for on-line brokerage operation of goods which was not required by the originally presented invention and as treated on merits in the earlier Office action mailed

on April 1, 2004. See MPEP § 806.05(d). It is also to be noted that for the same reasons claims 1-3 and 8-11 were restricted, see Office action mailed on March 8, 2004 and those claims are withdrawn subsequently.

Since applicant has received an action, mailed on 4/1/2004, on the merits for the originally presented invention [rejection of claims 4-7 and 12-28] filed on 2/2/2001, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 38-71 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The amendment filed on November 8, 2004 is presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03). The presented claims include only new claims 38-71 and are not readable on the elected invention because they are withdrawn from consideration as being directed to a non-elected invention, analyzed above.

Since this amendment, similar to the earlier amendment received on July 6, 2004 is non-responsive as the presented claims include claims that are not readable on the elected invention [originally filed claims 4-7 and 12-28] this action is being made Final action. See CFR :**§ 1.113 Final rejection or action, as quoted below:**

Quote: " (a) **On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicants, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in §1.114 or § 1.116. Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section.....§ 1.114 Request for continued examination: (a) If prosecution in an application is closed, an applicant may request continued**

examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of.....(2) Abandonment of the application;”.

Unquote: Accordingly, the rejection of elected invention, that is originally filed claims 4-7 and 12-28 is submitted below:

Claim Rejections - 35 USC § 101

3 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 4-7 and 12-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

2.1 Claims are directed to non-functional descriptive Material:

Claims 4-7 and 12-28 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter. Claims 4-7 and 12-28 are directed to several interfaces which represent disembodied data structure and are per se not statutory. C.f. In re Wamerdam. The examiner suggests to redraft the claims to include a computer readable medium so that the claimed software in combination with a computer readable medium will be capable of producing a useful, concrete and tangible result. A claim to a computer readable medium encoded with functional descriptive material that can function with a computer to effect a practical application that results in

a useful, concrete and tangible result (i.e. running an assembly line or executing a stock transaction) satisfies Section 101. See U.S. Patent 5,710,578 to Beauregard etc. These are merely stored to be read or outputted by a computer without any functional interrelationship, and thus do not impart functionality to the computer, i.e., they are not computer components. **Examples of Non-Functional Descriptive Material :Music, Literature, Art,Photographs, Data base per se are directed to neither a “process” nor a “machine,” but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only.** Id. at 1551.

2.2.Claimed inventions lack practical application.

Claims 4-7 and 12-28 are directed to several types of interfaces which represent disembodied data structure and fail to produce “useful, concrete, and tangible result” and therefore lacks a practical application. Since the claimed invention is not concrete because it fails to produce a practical application as required under 35 U.S.C. 101 the claims are analyzed as non-statutory subject matter.

The above analysis supported by court ruling per State Street Bank & Trust Co. v. Signature Financial Group Inc., 149 F. 3d 1368, 1374, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998). See MPEP 2106 II A: Identify and Understand Any Practical Application Asserted for the Invention. The claimed invention as a whole must accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of

this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); In re Ziegler, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

The above rejection is also supported by MPEP 2106 IV.B.2.b (ii): Computer-Related Processes Limited to a Practical Application in the Technological Arts: There is always some form of physical transformation within a computer because a computer acts on signals and transforms them during its operation and changes the state of its components during the execution of a process. Even though such a physical transformation occurs within a computer, such activity is not determinative of whether the process is statutory because such transformation alone does not distinguish a statutory computer process from a nonstatutory computer process. What is determinative is not how the computer performs the process, but what the computer does to achieve a practical application. See Arrhythmia, 958 F.2d at 1057, 22 USPQ2d at 1036. A process that merely manipulates an abstract idea or performs a purely mathematical algorithm is nonstatutory despite the fact that it might inherently have

some usefulness. In Sarkar, 588 F.2d at 1335, 200 USPQ at 139, the court explained why this approach must be followed:

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites the limitation "said displayed data" in line 10 of claim 12 on page 5 of the amendment. It is unclear if said displayed data is related to "displaying stored data" in line 4 or to "displaying stored load settlement data" in line 7. Since claims 13-28 are dependencies of claim 12 they all will also inherit the same deficiency.

Claim Rejections - 35 USC § 102

- 5 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an

application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 4-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Friend et al. (US Pub.No: 2001/0032165 A1), provided with IDS, paper # 3, hereinafter, as referred to as Friend.

Regarding claim 4, Friend discloses a set of application program interfaces for utilization on a computer in conjunction with an application program for facilitating commercial trading transactions (see at least FIGs. 1-5 ,paragraphs 0022 on page 3, 0039 on page 4 and 0043 on pages 4-5.) comprising:

a first interface that receives a buyer identification and a set of desired product identifications (see at least paragraph 0043 o pages 4-5, “*Other pages might be individualized for displaying or receiving buyer specific data, such as desired prices and quantities for particular types of commodities,* ” . Buyer specific data and information about desired commodities corresponds to the claimed set of desired product identifications. As regards receiving buyer identification please refer to paragraph 0075 on page 9 where the log in procedure for buyer includes receiving buyer identification. A member as disclosed in Friend applies to any user such as buyer or seller or transport vendor.). ;

a second interface that receives a seller identification, a set of available product identifications, and a set of associated product prices (see at least paragraph 0043 o pages 4-5..... while other pages might be individualized for a seller’s purposes, such as

presenting or receiving data regarding a desired sale price and a quantity.".

Seller 's data regarding sale price and quantity about commodities correspond to the claimed set of receiving information on a set of available product identifications and prices. As regards receiving seller identification please refer to paragraph 0075 on page 9 where the log in procedure for seller includes receiving seller identification. A member as disclosed in Friend applies to any user such as buyer or seller or transport vendor.);

a third interface that receives an inquiry product identification and returns a list of buyer and seller identifications associated with said product identification, together with said associated product prices (see at least paragraphs 0039 and 0040 on page 4 which discloses receiving bids from buyers for buying products and receiving seller's information about their commodities with prices). .

Regarding claims 5 & 6, Friend discloses that the said inquiry product identification is a desired product for the buyer and an available product from the seller (see paragraphs 0039-0040 on page 4. The buyer's bid order data and the seller's ask order data includes information about the desired product for the buyer and the available product from the seller respectively) .

Regarding claim 7, Friend discloses that the set of application program interface of Claim 4 including a fourth interface that receives a hauler identification and a set of hauling parameters; and wherein said third interface further returns a list of hauler identifications and hauling parameters (see at least paragraph 0043 on page 4, *"Presentation layer 16 is implemented as a number of graphic screens 22, since the*

*presentation layer must be able to communicate with buyers, sellers, **transporters**”, paragraph 0061 on page 7 and paragraph 0068 on page 8. “. Note “**transporters**” like buyers and sellers form one another group of users and are also subjected to log-in screens like any other user, that is buyer and seller for receiving their identification before being allowed to log on to the trading platform. See also paragraph 0075 on page 9. Also see paragraph 0059 on page 7).*

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 12-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friend.

Regarding claim12, Friend teaches a set of application program interfaces for utilization on a networked computer system in conjunction with an application program for facilitating commercial dairy product trading transactions (see at least FIGs.1-5 ,paragraphs 0022 on page 3, 0039 on page 4 and 0043 on pages 4-5.) comprising:

Friend discloses several interfaces that is first interface and second interface for receiving input information from buyers, sellers, transporters, etc. and displaying stored data in response to said received input information and wherein each of first and second interfaces each includes a plurality of interactive components for manipulating said displayed data (see paragraphs 0041-0043 on pages 4-5. Here, Fried teaches that registered buyers operating from their computer terminals 10 (see FIGs.1,2 and 4) can input information and the same is received by the interfaces on server 12 resulting in retrieving desired information from the stored data in database 20 and displaying the information through various interfaces 22 via presentation layer 16. The presentation layer 16 further individualizes/manipulates displaying data for a specific buyer or seller or transporter as the case may be.

Friend does not disclose receiving input load settlement information and for displaying the same in response to the input. However, load settlement information qualifies as descriptive material since it is directed to the content of data, not structure or an action or step. The step/action of receiving the input information and retrieving and displaying the desired information in response to the input would be done regardless the type of data, whether it is related to load settlement or buyer related or seller related or transporter related. Therefore, the specific contents recited in the claimed invention, that is load settlement data stored in the server does not patentably distinguish the claimed system, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to receive any type of input information in the system taught by Friend because the subjective interpretation of the queries does not patentably distinguish the claimed invention.

Regarding claims 13 and 16, Friend discloses a set of interfaces as disclosed and analyzed in claim 12. Friend further discloses that the set of application program interfaces of Claim 12 comprises:

a third interface for receiving input contact information and for displaying stored contact data in response to said received input contact information ;a fifth interface for receiving input product information and for displaying stored product data in response to said received input product information; a sixth interface for receiving input transportation information and for displaying stored transportation data in response to said received input transportation information; and a seventh interface for receiving input pricing information and for displaying stored pricing data in response to said received input pricing information((see at least paragraph 0043 on pages 4-5, “ *Other pages might be individualized for displaying or receiving buyer specific data.....might be individualized for a seller’s purposes..... visually interactive form*” . Note: This teaching implies that if the system in Friend receives a specific buyer information/contact data it displays the specific buyer information in response to the buyer’s input data and so on. Fried also discloses receiving input data and displaying

information related to pricing, product and transportation information , see paragraphs 0041-0043 on pages 4-5) .

Friend does not disclose a fourth interface for receiving input shipment schedule information and for displaying stored shipment schedule data in response to said received input schedule information and that said input shipment schedule information includes a contact identifier, a shipment date range, and a shipment schedule type selection. However, the shipment schedule information and related data qualifies as descriptive material since it is directed to the content of data, not structure or an action or step. The step/action of receiving the input information and retrieving and displaying the desired information in response to the input would be done regardless the type of data, whether it is related to shipment schedule and shipment related data, or pricing related or buyer related or seller related or transporter related. Therefore, the specific contents recited in the claimed invention, that is shipment schedule data stored in the server does not patentably distinguish the claimed system, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to receive any type of input information in the system taught by Friend because the subjective interpretation of the queries does not patentably distinguish the claimed invention.

Regarding claims 14-15, Friend teaches that said input contact information comprises alternatively a contact identifier, a contact type, a contact status, a contact category, or an entry from a predefined contact list and to display said stored contact data in a hierarchical format (see at least paragraph 0057 on page 7, paragraph 0061 on page 7, paragraph 0067 on pages 8-9. Note: Login information provides the contact identifier, and the user is allowed to choose among different categories of stored contact data in hierarchical order).

Regarding claims 17-19, 21, 23 its limitations are closely parallel to the limitations recited related to shipping schedule and other transportation related data and therefore is analyzed and rejected on the basis of same rational as unpatentable over Friend.

Regarding claims 20 and 22, friend discloses that the set of application program interfaces of Claim 13 wherein said fifth interface/sixth interface is configured to display said stored product/transportation information with a plurality of interactive links to associated contact information for product buyers, product sellers, and product haulers (see at least paragraph 0053 on page 6, “*...it is certainly within contemplation of the invention that the information or content provided by these adjunct providers could be merely pointed to, using HTML script, or the like, by a link list hosted on the web server portion of the trading platform server 12. In other words, third-party content could be hosted by the server or merely pointed to by the server, without effect on the scope and spirit of the invention.....*”. Note: HTML script in friend is configured to

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display said stored product/transportation information with a plurality of interactive links to associated contact information for product buyers, product sellers, and product haulers.).

Regarding claims 24 & 25, friend discloses that the set of application program interfaces of Claim 13 wherein said input pricing information includes a price basis and said seventh interface is configured to display said stored pricing information alternatively in a current market prices report or a pricing history report (see at least paragraph 0041 on page 4, “ *Data base 20 is particularly suitable for developing and maintaining statistical data regarding pricing trends....*” And paragraph 0043 on pages 4-5, “*displaying or receiving buyer specific data, such as desired prices.....*”).

Regarding claims 26-28, the limitation concerning storing data on load settlement , receiving input from a user for displaying load settlement information has already been discussed and analyzed in claim 12 above. Friend further discloses an interface configured to receive data related to buyer specific data, seller specific data, transportation related data from users (see paragraphs 0039-0043 on pages 4-5) and also use of e-mail server to generate and transmit at least one confirmation messages in response to said received information (see at least paragraphs 0051on page 6). Friend also discloses including a third interface configured to receive information from a user and to associate said received information with one or more customer account records (see at least paragraph 0093on page 12. All the information related to a

particular identifier can be searched, retrieved and displayed. The identifier corresponds to the claimed customer account record.). Friend also discloses that said one or more customer account records are accessible through an accounting interface.(see at least paragraph 0075 on page 9, “*Operationally, use of the system begins with a user's accessing the trading platforms' home pageFurther, a member must log in to the trading platform before entering any of the secure areas of the system such as the search, post, account management and member directory sections.....*”). Note: a user can access account records through an account management or member directory and that corresponds to the claimed invention.). Friend does not disclose that the said information data is related to a load settlement information. However, as analyzed and discussed above the load settlement information qualifies as descriptive material since it is directed to the content of data, not structure or an action or step. The step/action of receiving the input information and retrieving and displaying the desired information in response to the input would be done regardless the type of data, whether it is related to load settlement or buyer related or seller related or transporter related. Therefore, the specific contents recited in the claimed invention, that is load settlement data stored in the server does not patentably distinguish the claimed system, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). It would have been obvious to one of ordinary skill in the art at the time the invention was made to receive any type of input information in the system

taught by Friend because the subjective interpretation of the queries does not patentably distinguish the claimed invention.

Conclusion

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
January 24, 2005